

REMARK

The present application is being filed as a continuation of application Serial Number 09/089,271, filed June 2, 1998, ("the parent application") pursuant to 37 C.F.R. § 1.53 (b), which is entitled to the benefit of U.S. Provisional Application No. 60/060,416, filed September 30, 1997. The Applicant respectfully requests consideration of the present application as amended herein.

Claims 1-10, 12-16, and 19-25 have been amended. No claims have been cancelled. Claims 30-38 have been added. Therefore, claims 1-38 are present for examination.

35 U.S.C. §103 Rejection**Skytel in view of Bartle et al.**

In the parent application, the Examiner rejected Claims 1-7 and 11-13, 18-20, 23, and 26-27 under 35 U.S.C. §103 (a) as being unpatentable over Skytel, "Sky Word Plus - Store and Deliver Paging", product literature #1 ("Skytel #1") in view of U.S. Patent No. 5,732,347 of Bartle et al. ("Bartle"). Further, the Examiner rejected claim 21 under 35 U.S.C. §103 (a) as being unpatentable over Skytel.

Skytel #1 -- The Applicant hereby submits that Skytel #1 is derived from the invention described in the present application and that Skytel #1 thus is not effective prior art under 35 U.S.C. §103 (a). In this regard, declarations prepared pursuant to the requirements of CFR §1.132 are enclosed herewith. The declarations are signed by inventors Avinash L. Ghirnkar and Paul J. Lima and are accompanied by Exhibits A and B, which comprise the Skytel reference. (The current whereabouts of the other inventors,

Gregory J. Pinter and Carl Edward Lippett, were not discovered with reasonable diligence.)

The provisions of the declarations demonstrate that both the Skytel #1 reference and Skytel, "Sky Word Plus - Get Skytel. Get the Message." ("Skytel #2") are derived from the Applicant and that the Skytel #1 and Skytel #2 references describe the invention that was invented by the Applicant and that is the subject matter of the current application. Within the Skytel references, there is no contrary claim of inventorship on behalf of any party. For these and other reasons, Skytel #1 and Skytel #2 are not effective prior art in this application under the provisions of 35 U.S.C. §103 (a).

It is submitted that, although the Skytel references are attributable to the Applicant, Skytel #1 also would not be effective prior art under 35 U.S.C. § 102 (a). The Skytel #1 contains a notation of "04-97". Even if it were presumed that the material was released publicly on such a date, the date is within one year of the filing date of U.S. Provisional Application No. 60/060,416 on September 30, 1997. For this reason and other reasons, Skytel #1 is not effective prior art in this application under 35 U.S.C. §102 (a).

Bartle -- Regarding the remaining reference cited is Bartle, which discusses a method and apparatus for notifying the user of a digital cellular telephone regarding an imminent digital communication disconnection. (Bartle, col. 2, lines 3-6) Among other differences, **Claim 1** of the present application, as amended, provides for a *storing service mode*, a *basic service mode*, and a *full service mode* for a communication device. Bartle does not teach or suggest such service modes. In addition to numerous other

differences, Bartle does not discuss a wireless communication service that distinguishes between a *basic service* mode of operation and a *full service* mode of operation.

Bartle discusses the disconnection of a digital cellular phone under certain circumstances and transitions of a cellular telephone between different types of communications systems or between different communication cells. (e.g., Bartle, col. 2, line 35 to col. 3, line 6). Further, Bartle discusses transitions from personal communication systems and wireless private branch exchange systems to public cellular providers. (Bartle, col. 1, lines 48-64) However, none of the transitions and system hand-offs addressed in Bartle teach or suggest the modes of operation contained in Claim 1 of the present application.

Other Independent Claims -- The arguments regarding Claim 1 above also apply to the remaining rejected independent claims, **Claims 12, 21, and 26**. For these and other reasons, it is submitted that that such claims are allowable.

Dependent Claims -- The remaining rejected claims are dependent on claims 1, 12, 21, or 25 and, while also having distinguishing features over the prior art, such claims are allowable as being dependent on the allowable base claims.

Conclusion

Applicants respectfully submit that the prior rejections in the parent application have been overcome by amendment and by the remark set forth herein, and that the claims are now in condition for allowance. Accordingly, Applicant respectfully requests that the claims in the present application be allowed.

Invitation for a Telephone Interview

The Examiner is requested to call the undersigned at (303) 740-1980 if there remains any issue with allowance of the case.

Request for an Extension of Time

The Applicant respectfully petitions for an extension of time to respond to the outstanding Office Action pursuant to 37 C.F.R. § 1.136(a) should one be necessary. Please charge our Deposit Account No. 02-2666 to cover the necessary fee under 37 C.F.R. § 1.17(a) for such an extension.

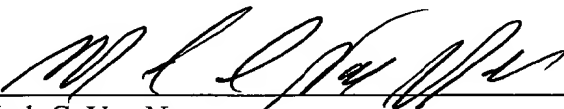
Charge our Deposit Account

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 4/18/01



Mark C. Van Ness
Reg. No. 39,865

12400 Wilshire Boulevard
7th Floor
Los Angeles, California 90025-1026
(303) 740-1980